

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 1, 5-6, 10-12, and 20 have been amended, and new claims 25-32 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §112 Second Paragraph

Claims 10 and 12 have been rejected under 35 USC §112, paragraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention. In response, each of the Examiner's stated reasons have been addressed in the foregoing claim amendments and are briefly summarized below.

Claim 10 has been amended to more clearly recite "disk speed features".

Claim 12 has been amended to more clearly recite "writable material", for which antecedent basis is provided in base claim 5.

In view of the foregoing, it is submitted that the rejections under 35 USC §112, paragraph 2, have been overcome and should be withdrawn.

Rejection Under 35USC §103

Claims 1-8, 10, 12, 14-17, 19-20, 22, and 24 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0191517 to Honda ("Honda") in view of U.S. patent 4,884,259 to Horikawa et al. ("Horikawa"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The rejection of independent claim 1, and its dependent claims 2-4, 17, and 19, is respectfully traversed for at least the following reasons. Claim 1 recites:

"1. (Currently amended) An optical disk, comprising:
a label region on the optical disk comprising a writeable material; and
a plurality of substantially identical disk speed features, located to be readable when writing the label region, to convey disk speed data without use of any other features on the optical disk." (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants' claim limitations.

The Office admits that “Honda does not disclose ‘disc [sic] speed features, located to be readable when writing the label region, to convey disk speed data’” (Office Action, p.3). The Office further states that Horikawa teaches such disk speed features, in the form of starting reference element 5 and angle reference marks 6 (Fig. 1). With regard to these marks 5,6, the Horikawa reference teaches:

“The optical memory disk 1 also has a starting reference mark 5 and a plurality (for example, 63) of angle reference marks, the marks 5, 6 being equally angularly spaced at angular intervals A along the outer circumferential edge of the disk 1. The marks 5, 6 can be detected by a reference mark position detector in the form of a photoelectric transducer, for example, when the optical memory disk 1 is rotated, and signals from the reference mark position sensor are used to determine angular positions of the optical memory disk 1. The marks 5, 6 may be of any desired shape insofar as they can produce different signals.” (col. 4, line 63 – col. 5, line 7; emphasis added)

“A reference mark position sensor 28 is positioned beneath the outer circumferential edge of the disk 1 for detecting the original and angle reference marks 5, 6 to issue reference pulses to a synchronous pulse generator 29. Since the marks 5, 6 total 64, the reference mark position sensor 28 produces 64 pulses per revolution of the disk 1.” (col. 6, lines 48-54)

The Horikawa reference thus discloses that both the single starting reference mark 5 and the 63 angle reference marks 6 must be detected in order to produce the 64 pulses per revolution that convey the disk speed information. There is no teaching or suggestion that disk speed information can be conveyed using only the 63 angle reference marks 6. Since the starting reference mark 5 causes the position sensor to produce a different signal from the angle reference marks 6, the starting reference mark 5 cannot be substantially identical to the angle reference marks 6. The features of the present invention are neither disclosed nor suggested by the applied references in that all the features of the Horikawa reference that convey disk speed data are not substantially identical, and that other non-identical features on the optical disk must be used in order to convey disk speed data.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. With regard to combining the Horikawa reference, the Office states that “The

motivation would have been to track the disc speed directly from the disc, instead of the spindle motor (as in Honda paragraph 37), improving reliability” (Office Action, p.3). Applicants respectfully believe that a mere assertion of improving reliability, in the absence of a specific teaching to that effect in one reference or the other, is just a conclusory statement of generalized advantages that impermissibly uses Applicants’ disclosure as a blueprint or in hindsight for the rejection.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants’ invention. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

The rejection of independent claim 5, and its dependent claims 6-8, 10, 12, and 14-16, is respectfully traversed for at least the following reasons. Claim 5 recites:

“5. (Currently amended) An optical disk, comprising:
a label region on the optical disk comprising a writeable material;
disk speed features, located to be readable when writing the label region, to convey disk speed data; and
disk angular orientation features different from the disk speed features, located to be readable when writing to the label side, to convey disk angular orientation data.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants’ claim limitations.

The Honda reference does not teach disk angular orientation features. The Office states that “the disk speed features taught by Horikawa include a starting reference mark, or disk angular orientation feature, 5: column 4, line 63 to column 5, line 7” (Office Action, p.4).

For similar reasons as explained heretofore with reference to claim 1, however, the disk angular orientation features of the Horikawa reference are not different from its disk speed features, as required by claim 5. Instead, the Horikawa reference uses starting reference mark 5 to determine both the disk speed and the angular orientation. The features of the present

invention are neither disclosed nor suggested by the applied references in that the disk angular orientation features of the Horikawa reference are not different from the disk speed features.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. The Office has not stated any additional motivation in the rejection of claim 5, and thus Applicants respectfully believe that a mere assertion of improving reliability, in the absence of a specific teaching to that effect in one reference or the other, is just a conclusory statement of generalized advantages that impermissibly uses Applicants' disclosure as a blueprint or in hindsight for the rejection.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

The rejection of independent claim 20, and its dependent claims 22 and 24, is respectfully traversed for at least the following reasons. Claim 20 recites:

“20. (Currently amended) A method of making an optical disk, comprising:
molding a plurality of substantially identical disk speed features configured to be viewed during labeling of the optical disk;
defining disk angular orientation features, different from the disk speed features, configured to be viewed during labeling of the optical disk; and
coating a label region on the label side of the optical disk with an OPU-writable coating.”
(emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants' claim limitations.

The Office states that “these claims are the inherent method of making the optical disc disclosed by Honda in view of Horikawa” (Office Action, p.6). However, independent claim 20 has been amended to include limitations similar to those of claims 1 and 5. Neither the Honda

reference nor the Horikawa reference, alone or in combination, disclose or suggest molding a plurality of substantially identical disk speed features and defining disk angular orientation features different from the disk speed features as recited in claim 20, for similar reasons as explained heretofore.

Furthermore, and also for similar reasons as explained heretofore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 8, 10, 14, and 17 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0191517 to Honda ("Honda") in view of U.S. patent 4,884,259 to Horikawa et al. ("Horikawa"), and further in view of U.S. patent 4,729,940 to Nee ("Nee"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of these claims on independent claims 1 or 5, whose reasons for allowability over the Honda and Horikawa references have been discussed heretofore and against which the Nee reference has not been cited.

Claims 20, 22, and 24 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent application publication 2002/0191517 to Honda ("Honda") in view of U.S. patent 4,884,259 to Horikawa et al. ("Horikawa"), and further in view of U.S. patent 4,729,940 to Nee ("Nee"). Applicants respectfully traverse the rejection and request reconsideration.

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants' claim limitations. Independent claim 20 has been amended to contain limitations similar to claims 1 and 5 that are not taught or

suggested by the Honda and Horikawa references, as discussed heretofore. The Nee reference is directed to the manufacturing of a master for optical disk reproduction, and accordingly does not teach or suggest molding a plurality of substantially identical disk speed features and defining disk angular orientation features different from the disk speed features as recited in claim 20, for similar reasons as explained heretofore.

. Furthermore, and also for similar reasons as explained heretofore, the Office has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to modify the reference or to combine reference teachings. The Office once again asserts improved reliability as the motivation. However, Applicants respectfully believe that the asserted motivation is just a conclusory statement of generalized advantages that impermissibly uses Applicants' disclosure as a blueprint or in hindsight for the rejection.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Therefore, the rejection of claim 20, and its dependent claims 22 and 24, is improper at least for these reasons and should be withdrawn.

Claims 9, 11, and 23 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0191517 to Honda ("Honda") in view of U.S. patent 4,884,259 to Horikawa et al. ("Horikawa"), and further in view of U.S. patent 6,109,324 to Bugner et al. ("Bugner"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of these claims on independent claims 5 or 20, whose reasons for allowability over the Honda and Horikawa references have been discussed heretofore and against which the Bugner reference has not been cited.

Claims 13, 18, and 21 have been rejected under 35 USC §103 (a), as being unpatentable over U.S. patent application publication 2002/0191517 to Honda ("Honda") in view of U.S. patent 4,884,259 to Horikawa et al. ("Horikawa"), and further in view of U.S. patent 5,670,947 to

Nagashima ("Nagashima"). Applicants respectfully traverse the rejection and request reconsideration based on the dependence of these claims on independent claims 1, 5, or 20, whose reasons for allowability over the Honda and Horikawa references have been discussed heretofore and against which the Nagashima reference has not been cited.

Formalities

Amendment of the Specification

Paragraph [0001] of the specification has been amended to supply the missing cross-referenced co-pending US application serial number, as requested by the Office.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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